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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 09/851,159  | 05/09/2001  | Walter Goerenz       | 3633-503                   | 2512             |
| 22850   | 7590        | 04/05/2004           |                            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>ROSSI, JESSICA |                  |
|   |             |                      | ART UNIT<br>1733           | PAPER NUMBER     |

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

|                        |                                      |                                       |  |
|------------------------|--------------------------------------|---------------------------------------|--|
| <b>Advisory Action</b> | <b>Application No.</b><br>09/851,159 | <b>Applicant(s)</b><br>GOERENZ ET AL. |  |
|                        | <b>Examiner</b><br>Jessica L. Rossi  | <b>Art Unit</b><br>1733               |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-3 and 5-22.

Claim(s) withdrawn from consideration: 4.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE:

Amendment not being entered because improper status identifiers used and therefore fails to comply with new rules for amendment practice as set forth in 37 CFR 1.121. Otherwise, amendment would have been entered. See attached document for response to Applicants arguments filed with non-compliant amendment.

Jessica Rossi  
571-272-1223

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 3/10/04 have been fully considered but they are not persuasive.
2. On pages 9-10 of the arguments, Applicant argues that ply 232 and connector 224 of Figure 4 of Winter '136 correspond directly with ply 116 and connector 124 of Figure 3 and therefore the surface coating 112 and connector 124 are located on the outside surface of the ply 116 opposite the PVB adhesive layer 234 when bonded to the second glass ply, whereas the present invention claims the surface coating and overlapping protective layer (equivalent to Winter's connector) being on the inside surface of the ply between the ply and adhesive layer.

The examiner respectfully points out that Applicant has misinterpreted the embodiments depicted in Figures 3 and 4. Figure 3 represents a "direct" connector 124 while Figure 4 represents a "capacitive" connector 224 (column 5, lines 7-11). Winter teaches the connector 224 can **alternatively** be positioned along **inner surface 214 of outer ply 216** to establish a direct connection between connector 224 and coating 212 as shown in Figure 3 (column 5, lines 24-26), wherein connector 124 directly corresponds with connector 224 and coating 112 directly corresponds with coating 212. Therefore, since inner surface 214 of outer ply 216 is clearly located on the **inside** of the glazing facing PVB layer 234, the skilled artisan would have appreciated that ply 116 of Figure 3 corresponds directly with ply 216 of Figure 4 and **NOT** with ply 232 as Applicant contends. Therefore, Winter teaches connector 224 and surface coating 212 being located on the inside surface of ply 216 between the ply 216 and PVB adhesive layer 234.

3. On pages 9-10 of the arguments, Applicant argues that Winter is concerned with providing a glazing with an antenna and in no way describes shaping and fabricating the edge region of two glass panels that are to be bonded together so as to provide a protective seal around the periphery of the glazing.

First, Applicants “protective seal” results from providing a protective layer 6 that overlaps a surface coating 5 located on one of the panes by extending between coated and uncoated regions of the pane near the peripheral edge thereof (see Figure 1). The protective layer is an electroconductive ceramic paint wherein the present invention fails to disclose and/or claim specific ceramic paints (p. 3, lines 5-7 and 24-25).

Although Winter does not expressly set forth a concern with providing a protective seal for the glazing, the reference does teach providing an electroconductive ceramic paint 124/224 (column 5, lines 32-35) that overlaps a surface coating 112/212 located on pane 116/216 by extending between coated and uncoated regions of the pane near its peripheral edge (Figure 3; column 5, lines 8-11 and 24-26). Although Winter does not expressly state that the electroconductive ceramic paint protects the glazing by being impermeable to diffusion of water vapor (see claims 1, 11, 18, 20, and 22) the skilled artisan would have appreciated that such protection is simply due to the nature of the electroconductive ceramic paint; therefore, since Winter also teaches an electroconductive ceramic paint the skilled artisan would have appreciated that it too would be impermeable to diffusion of water and therefore protect the glazing from such – even if this protection is not an expressly stated concern of Winter.

As for the “shaping and fabricating” of the edge region (i.e. removing edge portions of the surface coating to achieve a surface coating spaced from the peripheral edges of the pane),

the examiner provided ample motivation for such process steps as set forth in paragraph 10 of the previous office action with respect to the Koontz reference. Please refer to paragraph 4 below for further discussion.

4. At the end of the 1<sup>st</sup> paragraph on page 10 of the arguments, Applicant argues that Winter fails to teach or suggest edge shaping of the pane and removal of edge portions of the surface coating so that the subsequently applied protective layer overlaps a region of the surface coating and completely covers the exposed edge of the surface coating.

The examiner agrees that Winter teaches the surface coating being spaced from the peripheral edge of the pane, but is silent as to removing a portion of the coating to achieve this spacing. However, one skilled in the art would have resorted to such a removal technique to achieve the desired dimensions for the surface coating based on the teaching of Koontz, as set forth in paragraph 10 of the previous office action (Koontz teaches coating the entire surface of a glazing pane and removing edge portions of the coating to achieve the desired spacing from peripheral edges of the pane; column 4, lines 18-25), because this eliminates the time and money needed for precisely coating a select portion of the pane.

5. On page 11 of the arguments, Applicant argues that Koontz has nothing to do with modifying the edge construction of two glass plies being bonded together to form a glazing.

The examiner points out that Koontz was only used to show it is known in the glazing art to coat the entire surface of a glass ply and remove edge portions of the coating to achieve the desired spacing from peripheral edges of the ply. See paragraphs 10 and 11 of previous office action.

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6. On pages 11-12, Applicant argues that Tweadey fails to teach or suggest removing at least one edge of a transparent surface coating to expose a region between about 0.1-5 mm from the peripheral edge of the pane and then applying a protective layer proximate the peripheral edge of the pane so that it extends across the edge of the coating.

The examiner points out that Tweadey was only used to show it is known glazing art to apply a transparent surface coating to the entire surface of a glass pane and then remove edge portions of the coating to expose a region between about 0.025-3.18 mm from the peripheral edge of the pane (column 4, line 61 – column 5, line 5; column 5, lines 11-12). See paragraphs 10-11 of previous office action.

7. On page 13 of the arguments, Applicant argues that Shukuri and Marquardt fail to teach or suggest the specifics of claims 21 and 22.

The examiner points out that these references were only used to show it is known in the art to grind the peripheral edges of glass panes. See paragraph 12 of previous office action.

8. On pages 13-14 of the arguments, Applicants argues that Eisenfuhr, Siegfried, Carter, and Goerenz fail to overcome and improve upon deficiencies of the primary reference.

The examiner points out that these references were only used to show that removing a coating by abrading and/or grinding, covering an entire surface of a transparent coating located on a glass ply with an electroconductive ceramic paint, and bending a coated glass ply is known in the art.

***Conclusion***

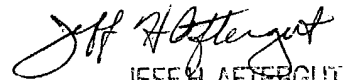
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica L. Rossi  
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Art Unit 1733



  
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